

RESPONSE UNDER 37 CFR §1.116

U.S. Application No. 10/628,557

Q76705

REMARKS

Claims 1-25 are all the claims pending in the application. Claims 1-6 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) in view of Knauerhase et al. (U.S. Patent No. 2004/0203847). Claims 7-12, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) and Knauerhase et al. (U.S. Patent No. 2004/0203847) with a view of Choi (U.S. Patent No. 6,967,944). Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) in view of Knauerhase et al. (U.S. Patent No. 2004/0203847) and Choi (U.S. Patent No. 6,967,944) in further view of Comstock et al. (U.S. Patent No. 2002/0183038).

Claim Rejections under 35 U.S.C. § 103

A. *Claims 1-6 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) in view of Knauerhase et al. (U.S. Patent No. 2004/0203847).*

In response to Applicant's argument that Zehavi fails to teach an operation control means which activates the wireless communication means when the judgment means is affirmative because Zehavi requires that the user activate communication not that the communication occurs by function of a control means contained within a wireless communication apparatus, the Examiner states "the examiner agrees with this interpretation where the broad claim language admits this application of Zehavi." See page 2 of the Office Action. Applicant respectfully submits that the Examiner's rationale is logically incorrect.

When a claim recites an element of an apparatus, the provision of a similar function performed by a user does not teach the apparatus feature. *In re Bell*, 26 USPQ 1529 (Fed. Cir. 1993). Therefore, because the Examiner apparently agrees that Zehavi teaches the activation of the communication is provided by a user, rather than a control means, the rejection should be withdrawn.

Further, the Examiner argues that Applicant “points out that Zahavi fails to teach a judgment means as to whether or not the wireless communication means is within a coverage area of the wireless communication equipment. … Secondary prior art Knauerhase is introduced to teach the detection of a hotspot or access point with notification to the user by beep or ring of the proximity of a service provider, paragraphs 0018, 0045 and 0047. The device notification alerts the user to address a pre-identified listed task, in this case, the transfer of image files as taught by Zehavi.” See Office Action, page 2.

With regard to the second argument, Applicant submits that the Examiner has misread Applicant’s argument in the Amendment filed April 20, 2006. Specifically, the Examiner has read the argument to state that Zehavi fails to teach a judgment means. While Applicant did state that Zehavi fails to teach a judgment means, the statement was made to simply note that the Examiner concedes that Zehavi fails to disclose the judgment means. The thrust of Applicant’s argument centers on Knauerhase also failing to teach or suggest a judgment means and that Knauerhase teaches away from combination with Zehavi. In regards to that argument, the Examiner has not provided an argument which answers the substance of the argument as is required by MPEP §707.07(f). MPEP §707.07(f) requires that “[w]here the applicant traverses

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any rejection, the examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it." The Examiner has not properly responded to the arguments presented on page 14 of the Amendment filed April 20, 2006 as to claim 1, because no answer to the substance of the argument regarding Knauerhase teaching away from a combination with Zehavi, is presented in the instant Office Action. Because the argument remains unrebutted, claim 1 is further allowable for this reason.

Claims 2-6 and 24 are allowable at least by virtue of their dependency from claim 1.

B. Claims 7-12, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) and Knauerhase et al. (U.S. Patent No. 2004/0203847) with a view of Choi (U.S. Patent No. 6,967,944).

Claims 7-9 are dependent from claim 1. Because Zehavi and Knauerhase fail to teach or suggest all of the elements of claim 1, and because Choi fails to cure the deficiencies noted in Zehavi and Knauerhase with respect to claim 1, claims 7-9 are allowable over the applied art.

The Examiner's rejection of claim 10 suffers from a similar problem as is noted with respect to claim 1, namely, that the Examiner has presented the same argument with respect to claim 10, but has not answered the substance of the arguments present by Applicant in the Amendment filed April 20, 2006. Therefore, claim 10 is allowable over the applied art, as Applicant's argument remains unrebutted. Claims 11, 12, 14 and 15 are allowable over the applied art at least by virtue of their dependency from claim 1.

C. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zehavi (U.S. Patent No. 2005/0083878) in view of Knauerhase et al. (U.S. Patent No.

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2004/0203847) and Choi (U.S. Patent No. 6,967,944) in further view of Comstock et al. (U.S. Patent No. 2002/0183038).

Claim 13 is dependent from claim 10. Because the Examiner has failed to rebut Applicant's arguments with regard to claim 10, claim 13 should be allowable at least by virtue of its dependency from claim 10.

Allowable Subject Matter

Claims 16-22 and 25 are allowable.

Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations to the base claim and any intervening claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

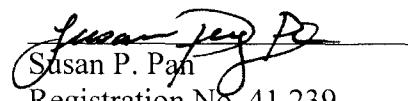
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Respectfully submitted,


Susan P. Pan
Registration No. 41,239

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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